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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,846	05/16/2006	Heino Weigand	ZEI-3305/500343.20326	7835
26418 7590 06/05/2009				
REED SMITH, LLP				
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NEW YORK, NY 10022-7650				
EXAMINER				
JONES, JAMES				
ART UNIT		PAPER NUMBER		
2873				
MAIL DATE		DELIVERY MODE		
06/05/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/595,846

Applicant(s)

WEIGAND ET AL.

Examiner

JAMES C. JONES

Art Unit

2873

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 May 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 11-14 and 16-20.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Jordan M. Schwartz/
Primary Examiner, Art Unit 2873

/James C. Jones/
Examiner, Art Unit 2873

Continuation of 11, does NOT place the application in condition for allowance because: 1. Applicant's arguments filed 5/20/2009 have been fully considered but they are not persuasive.

I. Applicant argues that Smith is not available under 103(a) for obviousness prior art because the effective filings date of the current application is December 2, 2004 and the publication date of Smith is September 7, 2006. However, Smith claims priority to provisional application number 60/608036. That application has a priority date of September 7, 2004. Smith is being used as a teaching reference to teach the limitation of "the movement of the fixation mark to make the eyes less likely to move during the treatment being carried out by the ophthalmologic treatment device". The aforementioned provisional application provides support for this teaching limitation (paragraph 0029). Therefore, as to this teaching limitation, Smith is entitled to the provisional application date of September 7, 2004 and therefore does qualify as prior art.

II. Applicant argues that Harino and Smith fail to disclose that the fixation mark is moved during the treatment being carried out. However, the Smith reference which is being relied upon as the teaching reference to establish a prima facie case of obviousness clearly discloses in par. [0118], lines 8-11, that the fixation mark is moved during the treatment being carried out. Smith, states that the fixation mark is moved to fix the patients eye during brief and extended testing, measuring and analysis procedures, which all fall under the umbrella of comprehensive treatment.

III. Applicant argues that Sponsel fails to disclose a fixation mark that is moved during the treatment being carried out. Sponsel is not being relied upon in the 103(a) rejection to disclose "a fixation mark that is moved during the treatment being carried out". The Smith reference is being relied upon as the teaching reference to establish a prima facie case of obviousness, clearly disclosing in par. [0118], lines 8-11, that the fixation mark is moved during the treatment being carried out.

IV. Applicant argues that one of ordinary skill of the art would not combine the disclosure of Sponsel with the disclosures of Harino and Smith because the treatments of Harino and Smith rely on the eye being in a fixed position. However, Sponsel also discloses that the fixation target is used to fix the gaze of the patient (see Sponsel par. [0048] lines 3-4), therefore it would have been obvious to a person having ordinary skill in the art to combine the disclosure of Sponsel with the disclosures of Harino and Smith. .